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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,020	07/31/2003	Carl Smith	VISAP076	4731
22434	7590	11/28/2006	EXAMINER	
BEYER WEAVER & THOMAS, LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			COLAN, GIOVANNA B	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/633,020

Applicant(s)

SMITH ET AL.

Examiner

Giovanna Colan

Art Unit

2162

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

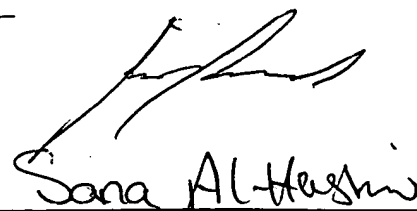
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Sana Al-Hajjawi

Continuation of 11. does NOT place the application in condition for allowance because:

1. Applicant cannot show non-obviousness by attacking references individually where, as here, the rejections are based on a combination of references.

In re Keller, 208 USPQ 871 (CCPA 1981).

2. Applicant argues that the prior art fails to disclose; "that the card framework template record is ever modified based upon responses to user queries".

Examiner respectfully disagrees. It is noted that the specific wording "the card framework template record" is not disclosed by the claim language. However, the combination of Tushie in view of Morris does disclose the claimed limitation of: "receiving from the user responses to the plurality of queries ..."; "modifying said default member profile ..." (Col. 6, lines 54 - 56, Tushie; and Page 6, [0038], lines 2 - 5, and 10 - 15; respectively, Morris).

3. Applicant argues that the prior art fails to disclose; "that a user is presented with a number of queries and is then given a choice to respond to those queries."

Examiner respectfully disagrees. It is noted that the claim language does not disclose the specific limitation "given a choice". However, the combination of Tushie in view of Morris does disclose the claim limitation of: "providing a user with a plurality of queries regarding said smart card features, said queries originating from said software tool" (Page 6, [0038], lines 2 - 5, Morris).

4. Applicant argues that the prior art fails to disclose; "the default member profile is modified using information originating from user responses to queries regarding smart card features".

Examiner respectfully disagrees. It is noted that the feature upon which applicant relies (information originating from user) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, the combination of Tushie in view of Morris does disclose the claim limitation of: "modifying said default member profile using said matched output data values (Page 12, [0098], lines 12 - 14, Morris).

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (Claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

However, the combination of Tushie in view of Morris discloses the claimed limitation of: modifying said default member profile using said matched output data values (Page 12, [0098], lines 12 - 14, Morris).

5. Applicant argues that the prior art fails to disclose; "that this person is responding to a plurality of queries concerning smart card features".

Examiner respectfully disagrees. It is noted that the specific wording "person is responding to a plurality of queries concerning smart card features" is not disclosed by the claim language (Additionally, see response to argument 4, in this Advisory Action above).

6. Applicant argues that the prior art fails to disclose; "that a user is inputting responses to a plurality of queries regarding smart card features".

Examiner respectfully disagrees. The specific limitation "a user inputting responses ..." was not disclosed in the claim language (Additionally, see response to argument 4, in this Advisory Action above).

7. Applicant argues that the prior art fails to disclose; "modifying a member profile using matched output data values that are derived from user responses to queries regarding smart card features".

Examiner respectfully disagrees. The specific limitation "... output data values that are derived from..." was not disclosed in the claim language (Additionally, see response to argument 4, in this Advisory Action above).

8. Applicant argues; "that the Office Action cannot rely upon two different references to show the same claim element ..."; that the references are; "different or completely unrelated"; "...absolutely non-analogous"; and that; "there is no motivation for anyone to combine". Examiner respectfully disagrees. The combination of Tushie in view of Morris does disclose all the limitations of the claimed invention including: providing a user with a plurality of queries regarding said smart card features (Page 6, lines 40 - 46, Tushie; and Page 6, [0038], lines 2 - 5, Morris), said queries originating from said software (Page [0060], lines 5 - 7, Morris). The teachings of Tushie and Morris are expected to work successfully together since both of them are arts in the same field of endeavor, such as, inputting information through interfaces, card features, personalization information to be used in cards.

9. Applicant also "questions whether Morris is prior art based upon its filing date".

Examiner relied on the provisional application filing date of the Morris reference. The provisional application of the Morris reference, which filing date is: May 15, 2002, does disclose the limitations cited in the Final Office Action dated August 22, 2006 (See Morris Provisional Application number: 60/381,085, Specification, Pages 6, 7, 10, and 29, Fig. 9).